

Docket No.: 26119.136E-US1
Serial No. 09/697,024

PATENT

REMARKS

In the Office Action, the Examiner noted that claims 12-33 and 44-46 are pending in the application, that claims 44-46 are withdrawn from consideration, and that claims 12-33 are rejected.

By this Amendment, claims 12, 28, 31, 32 and 33 have been amended. Therefore, claims 12-33 and 44-46 are pending in the application. The Examiner's rejections are traversed below.

Rejection Under 35 USC Section 112, Second Paragraph

Claims 12, 28, 31, 32 and 33 are rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicant considers the claims as being sufficiently clear. Nevertheless, Applicant has amended the claims to correct informalities.

With respect to claim 28, Applicant believes this claim is clear. Specifically, the bundle version identifier is used, in at least one embodiment, to provide the ability to determine the current version of the data element and/or copy of the data element, as described in the specification. Accordingly, Applicant respectfully submits that this claim is clear and definite.

With respect to claim 33, Applicant believes this claim is clear. Specifically, content blending is described in the specification as being used, in at least one embodiment, to create custom content collections based on bundle type, author, recipients, destination device or other

Docket No.: 26119.136E-US1
Serial No. 09/697,024

PATENT

criteria. The specification refers to a variety of examples, including allowing users or user firms to blend additional content into a bundle at different points in the system, including the creator's firm aggregation server, the system's core infrastructure, and/or the recipient's firm aggregation server. User applications can also allow for blending at the sender's and/or the recipient's desktop. In another example, a buy-side firm does not want its portfolio managers wasting time on bundles tagged with equities that their analysts have a sell recommendation on. To help avoid such problems, they can program their aggregation server to display their internal analyst recommendation for every equity a bundle is tagged with.

Applicants are not of the opinion that the amendments to the claims are narrowing amendments. Applicants respectfully submit that the claims satisfy the requirements under 35 U.S.C. § 112, second paragraph. Withdrawal of this rejection is respectfully requested.

Rejection Under 35 U.S.C. Section 103

Claims 12-33 are rejected as obvious in view of, Bowman (U.S. Patent 6,601,234: Attribute dictionary in a business logic services environment) and Frey (U.S. Patent 6,029,168: Decentralized file mapping in a striped network file system in a distributed computing environment).

Applicant respectfully disagrees.

Docket No.: 26119.136E-US1
Serial No. 09/697,024

PATENT

Bowman relates to a data access control method involves calling helper facade from application code for business object to set or update attribute values for auditing or rollback purposes, when a user is authorized. A system and method are provided for controlling access to data of a business object via an attribute dictionary. The attribute dictionary, which stores attribute names and values, is dispatched over a network. A helper facade is provided for interfacing a business object and the attribute dictionary. The helper facade is called to set, get, or update one of the attribute values based on the corresponding attribute name, wherein the helper facade shields the attribute dictionary from the application code of the business object. The attribute value in the attribute dictionary is obtained or updated if the verification is successful, and a dirty flag is set in the attribute dictionary and an indicator is broadcast upon the attribute value being updated.

Frey relates to a decentralized access managing method of files in distributed computer system, involves routing file block access request from one file access manager to other, based on specific determination result. Data files are distributed across a large scale data processing system to enable balance of work loads and storage loads at a plurality of nodes. Specifically, Frey distributes meta-data in a plurality of file storage nodes to isolatively and distributively store file data in a distributed computing environment.

In connection with the rejection of independent claim 12, the Examiner contends Bowman shows a bundle consisting of a data element reference and meta data the describes the data element at Column 233, lines 56+. Applicant disagrees. The Examiner has not shown how

Docket No.: 26119.136E-US1
Serial No. 09/697,024

PATENT

Bowman is related to the claimed "networked commercial interaction management method." Bowman does not show or suggest a commercial interaction management. In addition, Bowman does not disclose the claimed step of "assembling information into bundles, wherein each bundle comprises a data element reference and meta data describing the data element, and wherein each data element remains resident on a node of a data owner in a network." The reference to Bowman does not show or suggest bundling together a data element reference and meta data describing the data element.

Further, Bowman does not disclose "distributing the meta data from the bundles through the network, and distributing copies of the data elements in the bundles assembled in the step of assembling from the network node of their respective data owners to the network nodes of accessors, following selection of the data elements by the accessors."

The Examiner admits that Bowman is silent with respect to each data element remaining resident on a node of a data owner. See page 4 of Office Action. However, the Examiner contends that Frey discloses this feature. Applicant disagrees with the Examiner. Specifically, the Examiner references columns 5 and 6 of Frey that states that copying occurs whenever a file is retrieved from the resident node . . . and the data is copied into volatile memory. However, this merely refers to the downloading of data, for example, routing file block access request from one file access manager. Accordingly, Applicant respectfully submits that this section of Frey is unrelated to the claimed feature of, for example, "distributing the meta data from the bundles through the network."

Docket No.: 26119.136E-US1
Serial No. 09/697,024

PATENT

In addition, neither Bowman nor Frey show or suggest the claimed feature of "distributing copies of the data elements in the bundles assembled in the step of assembling from the network node of their respective data owners to the network nodes of accessors, following selection of the data elements by the accessors using the meta data and the data element reference distributed through the network." Therefore, nothing in Bowman and/or Frey shows or suggests the combination of claimed steps of distributing copies of the data elements recited in claim 12.

Specifically, without conceding that the cited prior art discloses any of the elements of the present invention recited in claim 12, Applicant respectfully submits that the prior art does not show or suggest the combination of limitations in claim 12, when claim 12 is interpreted as a whole. For example, claim 12 recites the following, in combination, a "networked commercial interaction management method." Frey and Bowman do not show or suggest a commercial interaction management. In addition, as described above, Frey and Bowman do not disclose the claimed step of "assembling information into bundles, wherein each bundle consists of a data element reference and meta data describing the data element, and wherein each data element remains resident on a node of a data owner in a network." Further, Frey and Bowman do not disclose "distributing the meta data and the data element reference from the bundles through the network, and distributing copies of the data elements in the bundles assembled in the step of assembling from the network node of their respective data owners to the network nodes of accessors, following selection of the data elements by the accessors using the meta data and the data element reference distributed through the network."

Docket No.: 26119.136E-US1
Serial No. 09/697,024

PATENT

Accordingly, Applicant submits that the combination of limitations recited in claim 12 patentably distinguishes over the prior art cited by the Examiner. Withdrawal of this rejection is respectfully requested.

In addition, Applicant respectfully submits that dependent claims 13-33 also patentably distinguish over the prior art for the specific combination of limitations recited in each of the claims, when each claim is interpreted as a whole, as well as the arguments provided below. Withdrawal of the rejection of these claims is respectfully requested.

The Examiner further cites inherency in the rejection of claims 13 and 15. Applicant respectfully submits that the features recited in claims 13 and 15 are not inherent. Inherency cannot be applied in an obviousness rejection.

Specifically, inherency and obviousness are separate and unrelated concepts. As stated by the Court of Customs and Patent Appeals:

[The] inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown.

In re Spormann, 363 F.2d 444, 150 USPQ 449, 452 (C.C.P.A. 1966). See also *MEHL/Biophile Int'l Corp. v. Milgram*, 192 F.3d 1362, 1365, 52 USPQ2d 1303, 1305-06 (Fed. Cir. 1999) ("Inherency is not necessarily coterminous with the knowledge of those of ordinary skill in the art. Artisans of ordinary skill may not recognize the inherent characteristics or functioning of the prior art.").

Further, the Patent Office Board of Patent Appeals and Interferences has similarly stated:

Docket No.: 26119.136E-US1
Serial No. 09/697,024

PATENT

[T]he examiner talks in terms of inherency (which is really an anticipation rationale) while on the other hand the examiner talks in terms that it would have been obvious to experiment to divine optimum conditions. Inherency and obviousness are somewhat like oil and water – they do not mix well. Claimed subject matter can be anticipated because a prior art reference describes a method which inherently meets the limitations of a claimed method. Claimed subject matter can be unpatentable for obviousness when, notwithstanding a difference between that subject matter and a prior art reference, the claimed subject matter, as a whole, would have been obvious. However, when an examiner relies on inherency, it is incumbent on the examiner to point to the "page and line" of the prior art which justifies an inherency theory.

Ex parte Schriker, 56 USPQ2d 1723, 1725 (B.P.A.I. 2000) (unpublished).

Accordingly, Applicant requests the Examiner to provide a prior art references or affidavit under 37 CFR 1.104(d)(2) to support this rejection. In the absence of either, Applicant respectfully requests the Examiner to withdraw the rejection. Thus, for this reason, withdrawal of the rejection of claims 13 and 15 is respectfully submitted.

In addition, with respect to the rejection of claim 13, the Examiner confuses the distribution to anyone that decrypt the data package with the claimed feature of "each bundle includes security information identifying entitled accessors of the data, and wherein the step of distributing only distributes the bundle to the entitled accessors." That is, in the present invention as recited in the embodiment of claim 13, the data bundle is distributed only to the appropriate recipients/accessors, rather than to both people having an encryption key and others not.

In addition, the Examiner cites Judicial Notice of Design Choice with respect to the rejection of claims 14, 19, 25, 29 and 30. Applicant traverses these rejections. With respect to

Docket No.: 26119.136E-US1
Serial No. 09/697,024

PATENT

claim 19, there is no such independent basis as "design choice" for which to base an obviousness rejection. For example, Patent Office regulations specifically state the following in the MPEP:

Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection). . . . The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.

MPEP § 2144.03. Accordingly, Applicant requests the Examiner to provide an affidavit under 37 C.F.R. Section 1.104(d)(2) detailing the reasons why it is well known, or to provide a prior art reference showing this feature. In the absence of either, Applicant requests the Examiner to withdraw the rejection.

Finally, no prior art has been applied against claims 28 and 31-33. Therefore, subject to the rejection regarding definiteness, Applicant respectfully submits that these claims are in a condition of allowance, and such action is respectfully requested. In addition, to the extent that the Examiner issues any new prior art rejection against these claims, Applicant respectfully submits that such action cannot be considered a final rejection.

Docket No.: 26119.136E-US1
Serial No. 09/697,024

PATENT

CONCLUSION

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, Applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples Applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicants assert that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicants have emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicants do not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicants are providing examples of why the claims described above are distinguishable over the cited prior art.

Applicants wish to clarify for the record, if necessary, that the claims have been amended to expedite prosecution. Moreover, Applicants reserve the right to pursue the original subject matter recited in the present claims in a continuation application.

Docket No.: 26119.136E-US1
Serial No. 09/697,024

PATENT

Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely Applicants' best attempt at providing one or more definitions of what the Applicants believe to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicants are seeking for this application. Therefore, no estoppel should be presumed, and Applicants' claims are intended to include a scope of protection under the Doctrine of Equivalents.

Further, Applicants hereby retract any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary to obtain allowance, and only maintains the arguments that persuaded the Examiner with respect to the allowability of the patent claims, as one of ordinary skill would understand from a review of the prosecution history. That is, Applicants specifically retract statements that one of ordinary skill would recognize from reading the file history were not necessary, not used and/or were rejected by the Examiner in allowing the patent application.

For all the reasons advanced above, Applicants respectfully submit that the rejections have been overcome and should be withdrawn.

For all the reasons advanced above, Applicants respectfully submit that the Application is in condition for allowance, and that such action is earnestly solicited.

Docket No.: 26119.136E-US1
Serial No. 09/697,024

PATENT

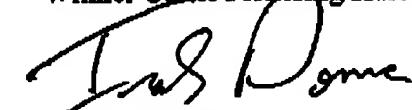
AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219

In the event that an Extension of Time is required, or which may be required in addition to that requested in a petition for an Extension of Time, the Commissioner is requested to grant a petition for that Extension of Time which is required to make this response timely and is hereby authorized to charge any fee for such an Extension of Time or credit any overpayment for an Extension of Time to Deposit Account No. 08-0219.

Respectfully submitted,

Wilmer Cutler Pickering Hale and Dorr LLP



Irrah H. Donner
Registration No. 35,120

399 Park Avenue
New York, NY 10022
TEL (212) 230-8887
FAX (212) 230-8888

Date: 2/16/06